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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,132	09/20/2000	Daisetsu Tohyama	48864-033	5773
7590 05/19/2004				
MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			EXAMINER GRANT II, JEROME	
			ART UNIT 2626	PAPER NUMBER 6
DATE MAILED: 05/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/661,132

Applicant(s)

YOKOMIZO, YOSHIKAZU

Examiner

Jerome Grant II

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-9 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 2-4, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

JEROME GRANT II  
PRIMARY EXAMINER

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Detailed Action

1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 9, 12 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Shiochi.

With respect to claim 1, Shoichi teaches a data communication apparatus (figure 3) which transmits image data to the other end 5, comprising: a first communication portion 51 for a first form of image data communication; a second communication portion 53 for a second form of image data communication; and a transmission controller 22 for selecting one of the first form and the second form in accordance with information indicating a color reproduction range (determined by color correction circuit 37) of the image output in the other end, wherein the image data are transmitted to the other end by the first or the second communication portion corresponding to the selected form. Note the range = hue difference as determined by the color temperature and white balance information ).

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With respect to claim 9, Shiochi teaches a communication method for transmitting image data from one end CCD to the other end, (color monitor) , the method comprising: a transmission control step (22) for selecting one of a first form and a second form, which are different. Shiochi teaches and a transmission controller 22 for selecting one of the first form and the second form in accordance with information indicating a color reproduction range (determined by color correction circuit 37) of the image output in the other end, wherein the image data are transmitted to the other end by the first or the second communication portion corresponding to the selected form. Note the range = hue difference as determined by the color temperature and white balance information ). Shiochi teaches a communication step 51 or 53 for transmitting image data to the other end which is selected by transmission switch step 22.

With respect to claim 12, Shiochi teaches a data communication method for transmitting data from one end to another, the method comprising: a reception step (performed by either of communication apparatus 1000 or 2000; reception controlling step (communication portion 1300) for receiving image data and deciding whether the image data are to be printed or not to be printed in accordance with a color range; memorizing step 9 via RAM 3) for memorizing data irrespective of it being printed. And a printing step according to col. 7, lines 30-40 which teaches printing data when it is in a range designated by the reproduction color information designated by a G4 fax apparatus. The printing of image data or the lack of printing thereof is based upon the capability of it to be printed as designated according to col. 7, lines 30-40.

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With respect to claim 13, it is clear however, that data content is stored in RAM. From the RAM data is printing if the predetermined conditions are met. Because data is always stored, there is the condition that data is stored in RAM 3 and subsequently a decision is made as to whether the contents is printed according to col. 7, lines 30-40.

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada

With respect to claim 5, Okada teaches a data communication apparatus, shown by figure 1, comprising: a communication portion (1300) for receiving image data; a memory RAM 3 for memorizing received image data; a printer (inherent in fax 1000, see also col. 8, lines 60-65); and a reception controller 1200 for deciding whether

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the image data are to be printed or to be memorized without being printed in accordance with the color range of the received image data.

What is not specifically taught by Okada is the memorizing without printed.

However, it would have been obvious to one of ordinary skill in the art to modify the controller 12 so that it will allow a memorizing of the image data to the communication apparatus and not print it out. It is well known to design controllers for printing and memorizing (storing data) based on a predetermined condition. The examiner submits that one of ordinary skill in the art would have known to modify the controller 1200 for the purpose of storing and not printing or printing and not storing.

With respect to claim 6, Okada teaches orchestrating printing within the range if the range is able to be designated. See col. 7, lines 30-40. Moreover, col. 7, lines 48-52 teaches storing range data. In addition, Col. 7, lines 30-40 addresses printing when the color range is in the reproduction range of the fax printer. But no discussion of the other use of memorizing when not performing the printing function.

However, it would have been obvious to one of ordinary skill in the art to modify the controller 12 so that it will allow a memorizing of the image data to the communication apparatus and not print it out. It is well known to design controllers for printing and memorizing (storing data) based on a predetermined condition. The examiner submits that one of ordinary skill in the art would have known to modify the controller 1200 for the purpose of storing and not printing or printing and not storing.

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With respect to claim 7, Okada teaches a communication portion for storing a fax reception , according to col. 7, lines 30-40 and col. 8, lines 15-21.

With respect to claim 8, Okada teaches printing an image if it is within the range of the printer. See col. 7, line 3. Moreover, Okada teaches printing if the received data is monochromatic. See col. 3, lines 14-16 and 50-57.

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiochi in view of Okada..

Shiochi teaches all of the subject matter upon which the claim depends except that it does not specifically address a communication step is a fax or e-mail procedure.

Okada teaches a communication means that is at least for fax.

While Shiochi teaches transmission of video data it does not do so under the normal facsimile protocols.

However, to one of ordinary skill in the art, once image data that has been scanned by a CCD 16a according to Shoichi , processed by a video processor and output to a device 5, it would have been obvious to one of ordinary skill in the art to replace the output means 5 with a transmission means (as suggested by Okada) for transmitting the still image video to another remote machines as done by Okada for the purpose of transmitting images.

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4.

#### Claims Objected

Claims 2-4, 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



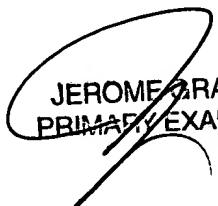
5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams, can be reached on 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II

  
JEROME GRANT II  
PRIMARY EXAMINER